

AMENDMENT  
November 28, 2005

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Serial No. 10/065,527

**REMARKS**

Claims 1 – 16 remain in the application and stand rejected. Claim 9 is amended. New claims 17 – 20 are added. No new matter has been added.

Claim 9 is objected to because of “executing on a processors,” and correction is required. Responsive thereto, claim 9 is amended herein. Reconsideration and withdrawal of the objection to claim 9 is respectfully requested.

Claims 4 and 12 are rejected under 35 USC §112 “as failing to comply with the enablement requirement.” However, paragraph 0014 clearly recites that “the plug-ins keep track of the objects to which they have added themselves and which were in the document originally. Preferably, the plug-ins add a hidden or **unseen marker** to the visual cue objects, but alternatively the plug-ins could keep a list of visual cue object IDs.” (emphasis added) So, since a skilled artisan would understand how to embed hidden markers in files (e.g., MSWord allows one to hide formatting marks), clearly, the specification enables “inserting an unseen marker” as claims 4 and 12 recite. Moreover, from the description of paragraph 0014, the unseen markers operate substantially the same as the “list of visual cue object IDs.” Thus clearly, the unseen markers (or the list) indicate corresponding document attributes, and may remain in the document after visual cues have been removed. Furthermore, paragraph 0014 is amended to recite that “when the visual cue objects are removed, the plug-ins locate any unseen markers that may have been previously inserted.” Bearing in mind that the specification includes the claims as filed, the amendment to paragraph 0014 is supported by claims 4 and 12. Thus, no new matter has been added. Again, a skilled artisan, knowing that the unseen markers will remain after deleting the visual cues, would know how to locate them. Accordingly, the specification, as filed and as amended, clearly supports and enables the present invention as recited in claims 4 and 12. Reconsideration and withdrawal of the rejection of claims 4 and 12 under 35 USC §112 for lack of enablement is respectfully requested.

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Paragraphs 0024 and 0026 have been amended typographically. No new matter has been added.

New claims 17 – 20 are added herein and are supported in the specification by paragraphs 0015 and 0016. No new matter has been added. No reference of record suggests or discloses “displaying the plurality of visual cue objects in thumbnails.” Neither does any reference of record disclose plug-ins to a document editor monitoring “thumbnails for current page selection.” Accordingly, new claims 17 – 20 are believed to be patentable over all references of record. Independent consideration and allowance of new claims 17 – 20 is respectfully requested.

Claims 1, 3 – 5, 9 and 11 – 13 are rejected under 35 USC §102(e) as being unpatentable over U.S. Patent No. 6,614,454 to Livingston. Claims 2 and 10 are rejected under 35 USC §103(a) as being unpatentable over Livingston in view of U.S. Patent No. 6,880,124 to Moore. Claims 6 – 8 and 14 – 16 are rejected under 35 USC §103(a) as being unpatentable over Livingston in view of published U.S. Patent Application No. 2002/0184305 to Simpson et al.

In rejecting claims 1, 3 – 5, 9 and 11 – 13 it is asserted that Livingston teaches the present invention, with reference to Figures 2 (step S5) and 3A and col. 4, lines 2 – 6, and col. 5, lines 17 – 20 and 38, 39.

Livingston teaches a “graphical user interface [GUI that] is configured to allow user selection and modification of print engine options for printing the document.” Col. 2, lines 19 – 21. Thus, “FIGS. 3A and 3B are simplified views of a graphical user interface for **controlling the printer** 12 of FIG. 1 using the process P1 shown in the flow chart of FIG. 2, ....” Col. 4, lines 12 – 14 (emphasis added). “When a feature is selected from the list 64, the second sub portion 58 is used to display **controls** for that feature.” Col. 5, lines 16 – 17 (emphasis added). “Displaying only the **controls** for the

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currently selected feature in the second sub portion 58 allows those controls to be viewed without distracting the user with controls for other features.”

Claim 1 clearly recites “creating an amended document” at line 4 and, thereafter, operates on the amended document. *See also*, claim 9, lines 8 – 9. Nowhere does Livingston teach “an amended document” as claims 1 and 9 recite. In particular, claim 1 recites at lines 5 – 8, that the amended document includes visual queues (and unseen markers or attendant list). *See also*, claim 9, lines 9 – 12. So, while the visual cues included in the amended document may represent print controls, the visual cues are not provided to the printer. *Id.* Instead, they are part of the amended document until they are removed “from the amended document, for specific operations to be performed on the amended document, at least one of the plurality of visual cue objects and performing the specific operations.” Claim 1, *supra*. Thus, “dog-ear corners are very useful when editing the job ticket in the application, but are not desirable in the printed output document. The job ticket parameters represented by the visual cues are stored or printed via the job ticket instead.” (emphasis added). This “amended document” is quite different, and operates quite differently, than the Livingston GUI.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipse dixit* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). MPEP 2131. So, although the reference may use a different term for an element recited in the claimed invention, at the very least, to form a basis for anticipation, a person of skill in the art must be able to use the teaching of the cited reference to carry out the invention.

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The MPEP, §2183 entitled, "Making a *Prima Facie* Case of Equivalence," provides in pertinent part that

If the examiner finds that a prior art element  
(A) performs the function specified in the claim

...  
the examiner should provide an explanation and rationale in the Office action as to why the prior art element is an equivalent. Factors that will support a conclusion that the prior art element is an equivalent are:

(A) the prior art element **performs the identical function** specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element disclosed in the specification...

(C) there are **insubstantial differences** between the prior art element and the corresponding element disclosed in the specification...

(D) the prior art element is a **structural equivalent** of the corresponding element disclosed in the specification. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). That is, the prior art element performs the function specified in the claim in substantially the same manner as the function is performed by the corresponding element described in the specification..., examiners should also demonstrate, where appropriate, why it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute applicant's described structure, material, or acts for that described in the prior art reference. See In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). The burden then shifts to applicant to show that the element shown in the prior art is not an equivalent of the structure, material or acts disclosed in the application. In re Mulder, 716 F.2d 1542, 219 USPQ 189 (Fed. Cir. 1983). No further analysis of equivalents is required of the examiner until applicant **disagrees** with the examiner's conclusion, and **provides reasons** why the prior art element should not be considered an equivalent...; and In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980) (a case indicating that the burden of proof can be shifted to the applicant to show that the subject matter of the prior art does not possess the characteristic relied on whether the rejection is based on inherency under 35 U.S.C. 102 or obviousness under 35 U.S.C. 103). (Emphasis added.)

Furthermore §2184 of the MPEP entitled, "Determining Whether an Applicant Has Met the Burden of Proving Nonequivalence After a *Prima Facie* Case Is Made," provides in pertinent part that "the indicia that will support a conclusion that one element

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is or is not an equivalent of another are: ... (A) Whether the prior art element **performs the identical function** specified in the claim in **substantially the same way**, and produces **substantially the same results** as the corresponding element disclosed in the specification." (Emphasis added.)

Accordingly, because Livingston does not teach inserting visual cues into an original document to create an amended document, and removing the visual cues from the amended document as claims 1 and 9 recite; Livingston fails to perform "**the identical function** specified in the claim [1 or 9] in **substantially the same way**, and [fails to produce] **substantially the same results**." *Id.* Thus, the applicants have met their burden in overcoming the allegation of *prima facie* anticipation based on direct anticipation by, or alleged equivalency of the present invention with, the Livingston GUI. Therefore, since the present invention, as recited in claims 1, 3 – 5, 9 and 11 – 13 is quite different and operates quite differently than the Livingston GUI; Livingston does not teach the present invention or an equivalent thereof, and so, does not anticipate the present invention. Reconsideration and withdrawal of the rejection of claims 1, 3 – 5, 9 and 11 – 13 under 35 USC §102(e) over Livingston is respectfully requested.

Regarding the rejection of claims 2 and 10 under 35 USC §103(a) over Livingston in view of Moore; Moore is cited because "Moore discloses automatically saving a document when printing (col. 7, lines 12-18)." Moore recites that "a first version of a communication is printed and altered to form a second version, and wherein the second version is subsequently digitized and compared to the first version." Col. 7, lines 4 – 6. "More specifically, and with reference to step (50) of FIG. 2, a communication is stored ... [in step 52] a portion of the communication is printed together with the identifier code ... [and in step 54] the printed communication is altered ... ." *Id.* 7, lines 6 – 27. Thus, Moore teaches printing before operating on the printed communications. Therefore, Moore does not provide anything to teach or suggest creating an amended document, which was missing from Livingston, to result in the present invention as recited in claims

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1 or 9, much less claims 2 and 10 depending therefrom. Accordingly, since dependent claims include all of the differences with the references as the claims from which they depend, Moore in combination with Livingston does not result in the present invention as recited in claims 2 and 10. Reconsideration and withdrawal of the rejection of claims 2 and 10 under 35 USC §103(a) over Moore in combination with Livingston is respectfully requested.

Regarding the rejection of claims 6 – 8 and 14 – 16 under 35 USC §103(a) as being unpatentable over Livingston in view of Simpson et al., it is asserted that “Simpson et al. disclose plug-in [sic] to a document editor providing a plug-in interface (page 1, paragraph 3).” However, neither does Simpson et al. provide anything to teach or suggest creating an amended document substantially as recited in the claims, which was missing from Livingston, to result in the present invention as recited in claims 1 or 9, much less, claims 6 – 8 and 14 – 16 depending therefrom. Since dependent claims include all of the differences with the references as the claims from which they depend, neither the combination Simpson et al. with Livingston, alone or, in further combination with either Moore or any reference of record, results in the present invention as recited in claims 6 – 8 or 14 – 16. Reconsideration and withdrawal of the rejection of claims 6 – 8 and 14 – 16 under 35 U.S.C. §103(a) over the combination Simpson et al. with Livingston is respectfully requested.

The applicants have considered the other reference cited, but not relied upon and find it to be no more relevant than the references upon which the rejections are based.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance, both for the amendment to the claims and for the reasons set forth above, the applicants respectfully request that the Examiner reconsider and withdraw the objection to claim 9, consider new

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claims 17 – 20, reconsider and withdraw the rejection of claims 1 – 16 under 35 U.S.C.  
§§102(e), 103(a), 112 and allow the application to issue.


Should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below for a telephonic or personal interview to discuss any other changes.

Please charge any deficiencies in fees and credit any overpayment of fees to IBM Corporation Deposit Account No. 50-3669 and advise us accordingly.

Respectfully Submitted,

November 28, 2005  
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